

## REMARKS

Claims 1-15, 17-20, 35-50, 52-56 and 58-62 are pending in the present application.

Claims 14, 15, 46-50, 53, 54, 59 and 60 are objected to as depending from rejected base claims.

Claims 1-13, 17-20, 35-45, 47-50, 52, 54-56, 58 and 60-62 stand rejected. Applicant has amended claims 12, 52, 58 and 62 and Applicant believes that the present application is now in condition for allowance, which prompt and favorable action is respectfully requested. Support for Applicant's amendments is found in at least paragraph [0049] of Applicant's as-filed specification. No new matter has been added.

**35 U.S.C. § 102(e) Anticipation Rejections**

Claims 1-8, 12, 13, 35-39, 41, 43-45, 52, 58 and 62 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 7,447,287 to Parantainen ("Parantainen"). Applicant respectfully traverses this rejection, as hereinafter set forth.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Brothers v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The identical invention must be shown in as complete detail as is contained in the claim. *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Applicant submits that Parantainen does not and cannot anticipate under 35 U.S.C. § 102 the presently claimed invention of independent claims 1, 12, 35, 52, 58 and 62 because Parantainen does not describe, either expressly or inherently, the identical inventions in as complete detail as are contained in the claims.

**Regarding independent claims 1, 12, 35, 52, 58 and 62**, Applicant's independent claims 1, 12, 35, 52, 58 and 62 recite the "*determining/determination*" of issuing a grant in response to a request for grant, *is performed within the base station* while Parantainen discloses determination is performed *outside of the base station*. Specifically, Applicant's independent claims recite, *inter alia*:

Claim 1: A *base station comprising ... a processing subsystem configured ... to make a determination* whether or not to issue a grant to the mobile station *in response to the request* for grant ....

Claims 12, 52, 58 and 62: ... to generate a request for transmission to a base station in a layer for determining at the base station whether or not to issue a grant to the mobile station in response to the request for grant ....

Claim 35: A method for a base station comprising ... determining at the base station whether to issue a grant to the mobile station in response to the request for grant

....

Clearly Applicant claims the determination in response to a request for grant occurs within the base station and not external to the base station as disclosed in Parantainen.

Applicant respectfully points out that the allegations relating to Parantainen in the Office Action do not correspond with Applicant's claims. The Office Action clearly cites to Parantainen which discloses the determination occurring outside the base station. Specifically, the Office Action alleges:

Parantainen teaches a transceiver subsystem (*BS: Fig. 1, element 102*); and *a processing subsystem (PCU; Fig. 1, element 103) configured ... to make a determination* whether or not to issue a grant to the mobile station in response to the request for grant .... (Office Action, pp. 2-3; emphasis added).

Applicant respectfully notes that Parantainen's "processing subsystem (PCU [] element 103)" wherein the alleged "mak[ing] a determination ... to issue a grant" occurs is external to Parantainen's base station "(BS [] element 102)" in Figure 1. Therefore, since Parantainen does not disclose Applicant's claimed invention in as complete detail as is contained in the claims as is required for a proper anticipation rejection under 35 U.S.C. §102, Parantainen cannot anticipate, according to 35 U.S.C. §102, Applicant's invention as presently claimed.

Accordingly, Applicant respectfully requests the rejections of independent claim 1 with claims 2-8 depending therefrom, amended independent claim 12 with claim 13 depending therefrom, independent claim 35 with claims 36-39, 41 and 43-45 depending therefrom, and amended independent claims 52, 58 and 62 be withdrawn.

**35 U.S.C. § 103(a) Obviousness Rejections**Obviousness Rejection Based on Parantainen and U.S. Pat. No. 6,836,666

Claims 9-11, 40 and 42 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Parantainen in view of U.S. Patent No. 6,836,666 to Gopalakrishnan *et al.* (“Gopalakrishnan”). Applicant respectfully traverses these rejections as hereinafter set forth.

The nonobviousness of independent claim 1 precludes a rejection of claims 9-11 which depend therefrom because a dependent claim is obvious only if the independent claim from which it depends is obvious. *See In re Fine*, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988), *see also* MPEP § 2143.03. Therefore, Applicant requests the Examiner withdraw the rejection to independent claim 1 and claims 9-11 which depend therefrom.

The nonobviousness of independent claim 35 precludes a rejection of claims 36-39, 41 and 43-45 which depend therefrom because a dependent claim is obvious only if the independent claim from which it depends is obvious. *See In re Fine*, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988), *see also* MPEP § 2143.03. Therefore, Applicant requests the Examiner withdraw the rejection to independent claim 35 and claims 36-39, 41 and 43-45 which depend therefrom.

Obviousness Rejection Based on Parantainen and U.S. Pat. No. 7,158,504

Claims 17-20, 49, 50, 55, 56 and 61 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Parantainen in view of U.S. Patent No. 7,158,504 to Kadaba *et al.* (“Kadaba”). Applicant respectfully traverses these rejections as hereinafter set forth.

The nonobviousness of independent claim 12 precludes a rejection of claims 17-20 which depend therefrom because a dependent claim is obvious only if the independent claim from which it depends is obvious. *See In re Fine*, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988), *see also* MPEP § 2143.03. Therefore, Applicant requests the Examiner withdraw the rejection to independent claim 12 and claims 17-20 which depend therefrom.

The nonobviousness of independent claim 35 precludes a rejection of claims 49 and 50 which depend therefrom because a dependent claim is obvious only if the independent claim from which it depends is obvious. *See In re Fine*, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988), *see*

also MPEP § 2143.03. Therefore, Applicant requests the Examiner withdraw the rejection to independent claim 35 and claims 49 and 50 which depend therefrom.

The nonobviousness of independent claim 52 precludes a rejection of claims 55 and 56 which depend therefrom because a dependent claim is obvious only if the independent claim from which it depends is obvious. *See In re Fine*, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988), *see also* MPEP § 2143.03. Therefore, Applicant requests the Examiner withdraw the rejection to independent claim 52 and claims 55 and 56 which depend therefrom.

The nonobviousness of independent claim 58 precludes a rejection of claim 61 which depends therefrom because a dependent claim is obvious only if the independent claim from which it depends is obvious. *See In re Fine*, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988), *see also* MPEP § 2143.03. Therefore, Applicant requests the Examiner withdraw the rejection to independent claim 58 and claim 61 which depends therefrom.

#### **Objections to Claims 14, 46, 53 and 59/Allowable Subject Matter**

Claims 14, 46, 53 and 59 stand objected to as being dependent upon rejected base claims, but are indicated to contain allowable subject matter and would be allowable if placed in appropriate independent form. Applicant acknowledges this indication with appreciation, but respectfully asserts that the claims in their present form, along with all other claims presently under consideration, are in condition for allowance.

Note: the Office Action is silent regarding the disposition of Applicant's claim 15 (depending from objected to claim 14), claims 47 and 48 (depending from objected to claim 46), claim 54 (depending from objected to claim 53), and claim 60 (depending from objected to claim 59). Applicant assumes claims 15, 47, 48, 54 and 60 are also objected to as depending from rejected base claims. Applicant asserts these claims are in condition for allowance.

**REQUEST FOR ALLOWANCE**

In view of the foregoing, Applicant respectfully submits that all of the pending claims in the application are patentable. Accordingly, reconsideration and allowance of this application are earnestly solicited. Should any issues remain unresolved, the Examiner is encouraged to telephone the undersigned at the number provided below.

Respectfully submitted,

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